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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/539,682	06/16/2005	Alexander Macasaet	30882/DP027	8592
4743 7590 10/24/2008 MARSHALL, GERSTEIN & BORUN LLP 233 S. WACKER DRIVE, SUITE 6300 SEARS TOWER CHICAGO, IL 60606			EXAMINER PERREAULT, ANDREW D	
			ART UNIT 3728	PAPER NUMBER
			MAIL DATE 10/24/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/539,682

**Applicant(s)**

MACASAET ET AL.

**Examiner**

ANDREW PERREAULT

**Art Unit**

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3, 5-13 and 15-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-13 and 15-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This office action is responsive to the amendment filed on August 28, 2008. As directed by the amendment: claims 1 and 5-7, have been amended, claims 4 and 14 have been cancelled, and new claims 17-19 have been added. Thus, claims 1-3, 5-13 and 15-19 are presently pending in this application.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-3, 5-13 and 15-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 7, "the sidewalls with different numbers of sidewalls" lacks antecedent basis and is indefinite as to what the "different numbers of sidewalls" refers to, the sidewalls previously defined, or other sidewalls.

Claim 10 recites the limitation "the cover" in line 1-2. There is insufficient antecedent basis for this limitation in the claim. Applicant has removed the prior limitation from claim 1.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent

protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 18, lines 7-8 recites the apparently broad recitation "transportation boxes", and the claim also recites "freight boxes", which is the apparently narrower statement of the range/limitation.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3, 5, 9-13, 17, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boersma (2003/0052038) in view of Allen (5,381,892).

Re claim 1, Boersma discloses a container (10; fig 11, 12, 13) including four sidewalls (26) with corners there between, the sidewalls defining an internal space for

storage of an item; the sidewalls being foldable about the corners (72, 176; fig 13) for ease of storage (fig 11, 12); the sidewalls having a base (19) and an open top (18); a pallet (14) with a planar and solid top onto which the sidewalls can be placed (fig. 11, 12); each sidewall of the container having a perforated line (70, 170, 172) to enable the height of the sidewalls to be varied, wherein the perforated line is parallel to an edge of the base for folding (fig 11, 12); but does not comprise that the base is open. However, Allen discloses a container (10; fig 1) with an open base (20). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device in the combined references, such that the base is open, as suggested and taught by Allen, for the purpose of decreasing the cost of production of the device because the top of the pallet may serve as a base for the intended storage item.

Re claim 2, Boersma discloses wherein the sidewalls are made of a material selected of cardboard (page 4, claim 2).

Re claim 3, the combined references do not disclose wherein the material is weather-resistant. However, it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. Official notice is taken that to provide a case of waterproof and corrosion resistant material would have been obvious in order to protect the contents and the case itself from such ambient negative conditions.

Re claim 5, Boersma discloses that the sidewalls are foldable along the perforated line to vary the height of the sidewalls (fig 11, 12).

Re claim 9, the combined references enable an item to be placed directly on the pallet. Furthermore, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Re claim 10, Boersma discloses a cover (16; fig 1, 5) that is shaped to conform with the internal space defined by the sidewalls and comprises a cover top (90), and cover sides (92), the cover being adapted to be readily removable over the open top and locatable on an outer surface of the four sidewalls in the manner of a snug fit (paragraph 40).

Re claims 11 and 12, the combined references do not comprise wherein the pallet is formed of a cardboard weather resistant material. However, it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. Official notice is taken that to provide a case of waterproof and corrosion resistant cardboard material would have been obvious in order to protect the contents and the case itself from such ambient negative conditions. Furthermore, using the same material (cardboard) as that of the container would reduce the costs to produce the device.

Re claim 13, Boersma discloses that the sidewalls and the pallet combine to form an open-top box (fig 11).

Re claim 17, Boersma discloses a cover (16; fig 1, 5) for the open top and the

internal space.

Re claim 18, Boersma discloses four sidewalls (26) with corners (72, 176; fig 13) therebetween for use in a container (such as 10; fig 11, 12, 13), wherein the sidewalls define an internal space for storage of one item, the sidewalls being foldable about the corners for ease of storage (fig 11, 12), having a base (19) and an open top (18), and each sidewall having a perforated line (70, 170, 172) to enable the height of the sidewalls to be varied, wherein each perforated line is parallel to an edge of the base and the height of each perforated line above the edge of the base is capable of being set to conform with industrial standards for freight or transportation boxes; but does not comprise that the base is open. However, Allen discloses a container (10; fig 1) with an open base (20). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device in the combined references, such that the base is open, as suggested and taught by Allen, for the purpose of decreasing the cost of production of the device because the top of the pallet already serves as a base for the intended storage item.

Re claim 19, the combined reference discloses a single standardized container (Boersma 10; Allen 10) that may be customized to meet the needs of different load and height requirements of objects to be stored and transported comprising the container. Furthermore, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex*

*parte Masham*, 2 USPQ2d 1647 (1987).

6. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combined references as applied to claim 1 above, and further in view of Rose (6,119,929).

Re claim 6, the combined references do not disclose wherein the sidewalls are shearable along the perforated line to vary the height of the sidewalls. However, Rose discloses a similar container (40; fig 4) with sidewalls (26, 28) and a perforated line (32); wherein the sidewalls are shearable ("a means for permitting the tearing" col. 15, line 8-32) along the perforated line to vary the height of the sidewalls. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device in the combined references, such that the sidewalls are shearable along the perforated, as suggested and taught by Rose, for the purpose of varying the height of the sidewalls to conform to different storage items.

7. Claims 7, 8, 15, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combined references as applied to claim 1 above, and further in view of Lochmiller (4,383,609).

Re claim 7, the combined references do not disclose wherein the top being of a length and width slightly greater than the corresponding dimensions of the sidewalls. However, Lochmiller discloses a container (40; fig 4, 6) with sidewalls (45, 46, 47, 48; col. 2, lines 12-13; fig. 4, 6); a pallet (10; col. 1, line 36; fig. 1, 6, 7, 9) with a planar and



solid top; wherein the top (fig 1) being of a length and width slightly greater than the corresponding dimensions of the sidewalls (fig 9). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device in the combined references, such that the top being of a length and width slightly greater than the corresponding dimensions of the sidewalls, as suggested and taught by Lochmiller, for the purpose of preventing the container from falling from the pallet by creating a larger pallet than the container.

Re claim 8, Lochmiller discloses wherein a gap is formed between an outer edge of the four sidewalls and a peripheral edge of the top of the pallet (fig. 9).

Re claims 15-16, Boersma and Lochmiller disclose that the top of the pallet forms a solid base for the sidewalls (respectively, fig 11, 12; fig. 9, 10).

8. Claims 2, 3, 11, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over combined references as applied to claim 1 above, and further in view of Barnes et al. (3,968,895).

As to claims 2-3 and 11-12, the combined references disclose the claimed invention but does not disclose that the sidewalls are made of a plastic weather-resistant material or that the pallet is formed of a plastic weather-resistant material. However, Barnes et al. teaches a similar container 1 (fig. 1) including four sidewalls 11a-11c, 15, a cover 37, and a pallet 3 (fig. 1) wherein the sidewalls 11a-11c, 15 are made of a material consisting of plastics (col. 5, lines 30-41), wherein the material is weather-resistant (col. 5, lines 30-41); and the pallet 3 is formed of a material of plastics

(col. 5, lines 30-41), wherein the material is weather resistant (col. 5, lines 30-41).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device in the combined references, such that the sidewalls and pallets are made of a plastic weather-resistant material, as suggested and taught by Barnes et al., in order for the container to be reused by being capable of withstanding damage from rough transporting conditions such as inclement weather and chemicals (col. 5, lines 30-41).

#### ***Response to Arguments***

9. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection. See the detailed explanation above.
10. This action is made non-final in view of the new grounds of rejection.

#### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Youell (5,441,154) discloses a container capable of having a different number of sidewalls (such as three, five, or six; col. 5, line 29-45).
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANDREW PERREAULT whose telephone number is (571)270-5427. The examiner can normally be reached on Monday - Friday, 8:00 AM -

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5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571)272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. P./  
Examiner, Art Unit 3728

/Bryon P. Gehman/  
Primary Examiner, Art Unit 3728